

REMARKS

In response to the Office Action dated July 9, 2008, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks.

Applicant respectfully requests entry of the foregoing amendments, which place the application in condition for allowance or in better condition for appeal.

Applicant appreciates the Examiner's comprehensive examination of the application. Applicant also appreciates the Examiner's provision of responses to Applicant's arguments to advance prosecution of the present application.

Status of the Claims

Claims 16, 24-28, 44, 52-56, 72 and 80-84 stand rejected under Section 112. Claims 1-2, 4, 6-15, 19-23, 29-30, 32, 34-43, 47-51, 57-58, 60, 62-71, 75-79 and 85 stand rejected under Section 103(a) as being unpatentable over U.S. Patent No. 6,374,241 to Lamburt (Lamburt) in view of Items U1-X7 cited in the PTO-892 (collectively referred to herein as "Superpages"). Claims 16, 24-28, 44, 52-56, 72 and 80-84 stand rejected under Section 103(a) as being unpatentable over Lamburt in view of Superpages and further in view of U.S. Patent No. 7,062,466 to Wagner (Wagner).

The Rejections under Section 112

Claims 16, 24, 44, 52, 72 and 80 have each been amended to delete the recitations regarding issuing a bill to a customer, and have each been further amended to recite that "the solicitation for billing information includes instructions directing the customer to enter billing data." Support for the latter amendment can be found at page 16, lines 4-6, of Applicant's specification. Applicant respectfully submits that the rejection under Section 112 has been overcome and requests withdrawal of the rejection.

The Rejections under Section 103

Applicant again hereby incorporates by reference Applicant's arguments as set forth in Applicant's Response dated October 19, 2007. Applicant respectfully submits that those arguments apply to the current rejections as well. In particular, the ordinarily skilled artisan

would not understand Lamburt to disclose or teach permitting a customer to configure a particular, unique, individualized, customized business listing and receiving an order request from the customer via the Web site to place an order for the customized business listing in the business directory as claimed. As best understood and discussed in the prior Response, the Superpages reference itself teaches a method for enabling placement of an order in the context of Lamburt that requires interfacing with a sales representative. Traditionally, listing enhancements have been offered to customers through direct interactions or negotiations with sales representatives of the business directory offeror. Thus, the ordinarily skilled artisan in view of Lamburt, particularly in further view of Superpages, would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative.

In response to the foregoing arguments, the Action states:

In response to applicant's argument that "the ordinarily skilled artisan in view of Lamburt would expect that the only ordering options for listing enhancements in Lamburt would require interfacing with a sales representative." It is noted with regard to this application and this argument that if such an expectation is present within the art then it would also apply to the present application. If such an implication is automatic, as argued by the applicant, then there is nothing indicating that the present invention does not do the same. Recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant respectfully submits that the noted differences between the claimed methods, systems and computer products and the methods, systems, and computer program products of Lamburt as properly modified in view of Superpages cannot be properly regarded as merely "intended use." For example, Claim 1 explicitly recites, *inter alia*, a step of:

receiving an order request from the customer via the Web site to place an order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

Similarly, Claim 29 explicitly recites, *inter alia*:

means for receiving an order request from the customer via the Web site to place an order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

Similarly, Claim 57 explicitly recites, *inter alia*:

computer readable program code configured to receive an order request from the customer via the Web site to place an order for the particular, unique, individualized, customized business listing in the business directory, including the first and second optional listing enhancements requested by the customer.

The foregoing recitations (and further recitations not quoted here) are recitations of actual steps, structure or computer readable program code, not merely recitations of intended use. Thus, the expectation present in the art would not apply to Applicant's methods, systems and computer program products as claimed because Applicant's claims explicitly recite steps or elements contrary to said expectations.

By contrast, a customer of Lamburt would not place an order request via the Web site as claimed, because the Lamburt system as configured ostensibly is not configured to solicit, process and receive such an offer. Similarly, the Lamburt system would not include means for receiving an order request or computer readable program code configured to receive an order request as claimed. Restated, Lamburt is not capable of performing the steps or even the intended use of Claims 1, 29 and 57.

In view of the foregoing, Applicant submits that the explicit limitations of Claims 1, 29 and 57 cannot properly be disregarded as intended use. As previously discussed, neither Lamburt nor Superpages suggests a method, system or computer program product as claimed.

In view of the foregoing, Applicant respectfully submits that Claims 1, 29 and 57 are allowable over the cited art. Claims 2, 4, 6-16, 19-28, and 85 depend from Claim 1, Claims 30, 32, 34-44, and 47-56 depend from Claim 29, and Claims 58, 60, 62-72, and 75-84 depend from Claim 57, respectively, and these claims are therefore allowable as well for at least these reasons.

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CONCLUSION

Applicant respectfully submits that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,




David D. Beatty
Registration No. 38,071
Attorney for Applicant

USPTO Customer No. 39072
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

CERTIFICATION OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 9, 2008.



Katie Wu
Date of Signature: September 9, 2008